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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,094	04/12/2002	Jun-Ichi Kawakami	2617 USOP	4051

23115 7590 04/04/2003

TAKEDA PHARMACEUTICALS NORTH AMERICA, INC  
INTELLECTUAL PROPERTY DEPARTMENT  
475 HALF DAY ROAD  
SUITE 500  
LINCOLNSHIRE, IL 60069

EXAMINER

SHIAO, REI TSANG

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 04/04/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/019,094

Applicant(s)

KAWAKAMI, JUN-ICHI

Examiner

Robert Shiao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on application received on 04/12, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,5-9,11-14,17 and 35 is/are pending in the application.
- 4a) Of the above claim(s) 2-4,10,18-34 and 36-42 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,5-9,11-14 and 35 is/are allowed.
- 6) ☒ Claim(s) 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 16
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other

### DETAILED ACTION

1. This application claims benefit of the foreign application:  
Japan 11/175070 with a filing date June 22, 2000.
2. Amendment of claim 35 and cancellation of claims 15-16 in Paper No. 13, dated February 6, 2003, is acknowledged. Claims 1, 5-9, 11-14, 17, and 35 are pending in the application.

#### ***Objection of Abstract***

3. The abstract of the disclosure is objected to because:

Applicant is reminded of the proper content of an Abstract of the Disclosure.

In chemical patent abstracts for compounds or compositions, the general nature of the compound or composition should be given as well as its use, *e.g.*, "The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics." Exemplification of a species could be illustrative of members of the class. For processes, the type reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary.

Complete revision of the content of the abstract is required on a separate sheet. Correction is required. See MPEP § 608.01(b).

4. Rejection of 35 U.S.C. 112 second paragraph of claim 35 and rejection of 35 U.S.C. 103(a) of claims 15-17 in Paper No. 11, is acknowledged. In response to applicant's amendment filed in Paper No. 13, dated February 6, 2003, have been fully

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considered. Rejection of 35 U.S.C. 112 second paragraph of claim 35 has been overcome herein. Applicant's arguments with respect to the 35 U.S.C. 103(a) rejection of claims 15-17 by Iwasaki's publication, Helvetica Chimica Acta, 1976, 59(8): 2738-2752, have been fully considered but they are not persuasive. Iwasaki discloses a compound of instant formula IIIa, wherein R' is an optionally substituted alkyl group having 3 or more carbon atoms. A number of compounds have been exemplified in page 2740 Table 1 compounds b -d. However, rejection of 35 U.S.C. 103(a) of claims 15-16 has been withdrawn due to cancellation of claims 15-16 in Paper No. 13.

5. In response to applicant's arguments with respect to claim 17 filed in Paper No. 13, have been fully considered but they are persuasive. Applicant's arguments with respect to claim 17 have been considered but are moot in view of the new grounds of rejection.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 17 is rejected under 35 U.S.C. 102(a) as being anticipated by Tasaka et al.

'WO 9954309, see CAS:131:299449.

Applicants claim a compound 1-(1H-imidazol-4-yl)-2-methyl-1-propanone in the instant claim.

Tasaka et al. disclose a compound 1-propanone, 1-(1H-imidazol-4-yl)-2-methyl-, which clearly anticipates the instant claimed compound, see CAS:1999:691084, RN:247174-71-6.

7. Claims 1, 5-9, 11-14, and 35 are neither anticipated nor rendered obvious over the art of record, and therefore are allowable over the art of record. This invention relates to "Process for the preparation of imidazole derivatives". The closest prior art are Iwasaki's publication, *Helv. Chim. Acta*, 1976, 59(8):2738-52. Suggestion for modification of processes of above record to obtain processes for preparing imidazole derivatives of instant claims, has not been found.

#### ***Telephone Inquiry***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (703) 308-4002. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (703) 308-4537. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

*R.S.*

Robert Shiao, Ph.D.  
Patent Examiner  
Art Unit 1626

*Joseph K. McKane*

Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626

April 3, 2003